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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,550	04/15/2005	Alain Soyser	09669/060001	1417

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EXAMINER

KOYAMA, KUMIKO C

ART UNIT PAPER NUMBER

2876

DATE MAILED: 05/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/531,550

Applicant(s)

SOYER ET AL.

Examiner

Kumiko C. Koyama

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>0505</u> .  | 6) <input type="checkbox"/> Other: ____                                     |

## DETAILED ACTION

Preliminary Amendment received on April 15, 2005 has been acknowledged.

### *Specification*

1. The abstract of the disclosure is objected to because it includes improper language, such as "embodiments" and "is provided." The abstract should avoid using legal phraseology and phrases which can be implied. Correction is required. See MPEP § 608.01(b).

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imataki et al (US 5,744,795) in view of Saito et al (US 4,754,319).

Re claims 1, 2 and 8: Imataki shows in Fig. 2(b), a card 201, which is a portable object, having a first side (the upper side with respect to Fig. 2(b)) and a second side (the lower side with respect to Fig. 2(b)). Imataki discloses that a concavity 301 is provided in the optical card as shown in Fig. 3(b). As shown in Fig. 3(b), the concavity is formed on the first side (the upper side with respect to Fig. 3(b)). The IC module 204 is bonded to the substrate 206 at the bottom of

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the concavity 301 by means of an adhesive layer 209 (col 4, lines 6-10). The IC module is a first electronic information support.

Imataki fails to disclose a second electronic support or a second cavity.

Saito teaches an IC card having two IC chips 26 as shown in Fig. 1. Saito also discloses that the sheets of card is formed with two apertures 38 and apertures 22 that are large enough to receive the embedded IC chips 26 (col 4, lines 5-11). As shown in Fig. 2, the two chips 26 are aligned with each other, and the apertures for them are also aligned with each other. Saito also shows in Fig. 1 that the card is a right parallelepiped.

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Saito the teachings of Imataki in order to reduce the number of cards by combining two cards having two IC chips into one card having two chips, and therefore, providing a multi-purpose chip card.

Re claims 3 and 9: As described above, Imataki discloses that the IC module 204 is bonded to the substrate 206 at the bottom of the concavity 301 by means of an adhesive layer 209 (col 4, lines 6-10). The IC module comprises an integrated circuit, and therefore, the integrated circuit is inserted into the module. Imataki also discloses that the IC module is provided for information storage means (col 1, lines 49-52).

4. Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imataki in view of Saito as applied to claim 1 above, and further in view of Fidalgo et al (US 6,448,638). The teachings of Imataki as modified by Saito have been discussed above.

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Imataki as modified by Saito fails to teach that the first electronic information support is arranged to be detached from the portable object. Imataki also fails to teach a smartcard as defined in ISO 7816 and a second generation SIM card.

Fidalgo discloses that it is possible to simply transform the card, or a large card known as a SIM card, whose format is in accordance with the international standards GSM 11.11 and ISO 7816, into a standardized mini SIM card, whose dimensions are also defined by the international standard GSM 11.11, by detaching the latter from the card by breaking the lugs or connecting bridges.

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Fidalgo to the teachings of Imataki as modified by Saito in order to enable the user to use the chip with a card in one or other of two formats according to the use and convenience of the user, and therefore, being able to accommodate various card readers.

5. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imataki in view of Saito as applied to claim 8 above, and further in view of Huber et al (US 6,025,997). The teachings of Imataki as modified by Saito have been discussed above.

Imataki as modified by Saito fails to teach that the cavities are created by milling or molding.

Huber discloses that for incorporation of the chip module in the chip card, currently three different methods have become established, the laminating method, insertion into milled cavities, and mounting in ready injection-molded cards (col 2, lines 1-5).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to modify the teachings of Huber to the teachings of Imataki as modified by Saito because all of the three established methods securely, but safely attaches the IC chip or module into the card, and it is a matter of preferential choice as to which method is utilized.

### *Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lasch et al., U.S. Patent Application Publication No. 2003/0141373, discloses a transaction card with dual IC chips.


Luu, U.S. Patent Application Publication No. 2003/0213849, discloses a contactless transaction card having two IC chips.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kumiko C. Koyama whose telephone number is 571-272-2394. The examiner can normally be reached on Monday-Friday 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Kumiko C. Koyama  
May 15, 2006

  
**STEVEN S. PAIK**  
**PRIMARY EXAMINER**